

**REMARKS**

Claims 1-23 are pending. Of those, claims 1-2, 8-9 and 14-15 are independent. By this reply, claims 21-23 have been added.

**Allowable Subject Matter**

Applicants acknowledge with appreciation the indication that claims 2-3, 9 and 15-16 are allowed.

**Claim Objection**

On page 2 of the Office Action, claim 5 has been objected to as containing a typographical error. Applicants appreciate the Examiner's help in the form of identifying the typographical error and suggesting a correction. By this reply, claim 5 has been amended to adopt the Examiner's suggested clarification. Accordingly, withdrawal of the objection is requested.

**§102 Rejection**

Beginning on page 3 of the Office Action, the Examiner has rejected claims 1, 4, 7 and 8 under 35 U.S.C. §102(b) as being anticipated by Applicants' Admitted Prior Art ("APA").<sup>¶¶</sup> This rejection is traversed.

The APA describes a manual process conducted by a system administrator. In contrast, amended claim 1 (for example) recites a machine-implemented method by which a proposed set of changes is received, e.g., from the system administrator, and by which it is automatically determined whether application of the changes would violate a set of constraints.

In an interview with one of Applicants' representatives conducted on September 28, 2005, some of the present claim amendments were discussed. At that time, the Examiner asserted that the proposed claim amendments would have been obvious, characterizing them as mere automation of the

previously manual process of the APA. Undoubtedly, the Examiner's assertion was informed by MPEP § 2144.04.III ("Automating A Manual Activity").

MPEP § 2144.04.III cites *In re Venner*, 120 USPQ 193, 194 (CCPA 1958). Among some Examiners, the Venner case has come to stand for the proposition that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is obvious. While such a statement is made in the Venner case, there is a tendency among some Examiners to ignore that it is underpinned by how very close the applied art was to Venner's claimed invention. Here, the APA is not so close.

Further, it is questionable whether the Venner case remains good law. For example, there is a dearth of case law citing the Venner case for the its holding touted in MPEP § 2144.04.III. Even a mere nine years after the Venner case was decided, the court in the Decca case<sup>2</sup> chose not to rely on the Venner case for its holding touted in MPEP § 2144.04.III. despite it being asserted by the Defendant as grounds for invalidity. The Decca case states:<sup>3</sup>

Defendant's contention that the '980 patent does not constitute an invention because it merely provides an automatic means to replace a manual activity used in the prior art to accomplish the same result is not supported in this case. Without deciding the validity of the proposition for which defendant cites the case of *In re Venner* and *Bowser*, 262 F.2d 91, 46 CCPA 754, 120 USPQ 192 (1958), it is concluded that the incorporation of automatic phase controlling circuitry in a pulse transmission system does not constitute the mere substitution of automatic means for a known function previously performed by manual activity. The phase discriminator and phase regulator of the '980 patent operate in a manner substantially different from the activity of an operator who manually controls the transmitting operation.

The Decca court instead distinguished the operation of the claimed phase discriminator and phase regulator as being substantially different than the activity of the operator who manually carries out the prior art process.

Here, Applicants submit that the machine-implemented method of claim 1 is patentable over the APA in the analogous way that the claims in the Decca case were held patentable. More

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<sup>1</sup> Applicants admit that the APA does not represent a point of novelty for the present application and will assume for the sake of argument that it is available under some section of 35 U.S.C. §102. But Applicants do not admit that the APA necessarily is §102(b)-type art.

<sup>2</sup> *Decca v. United States*, 160 PQ 739, 750 (US Cl.Ct 1969).

<sup>3</sup> *Decca*, 160 PQ at 750.

specifically, the method of present claim 1, by which a proposed set of changes is received and by which it is automatically determined whether application of the changes would violate a set of constraints, defines patentably distinct activity relative to what as done manually by the system administrator in the APA.

Claims 4 and 7 depend from claim 1 and at least similarly distinguish over the APA, respectively.

Amended independent claim 8 recites features similar to those of claim 1 noted above and thus similarly distinguishes over the 'APA.

In view of the foregoing discussion, the §102 rejection of claims 1, 4, 7 and 8 over the APA is improper and Applicants request that it be withdrawn.

#### **Rejection Under 35 U.S.C. § 103**

Beginning on page 3 of the Office Action, claims 5, 6, 11, 12, 14 and 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of "Dynamically Tunable Kernel Parameters in HP-UX 11i" an HP-UX 11i white paper from Hewlett-Packard (cited in IDS dated 5/6/2005, hereinafter, "the White Paper"). This rejection is traversed.

Claims 5, 6, 11 and 12 depend from claims 1 and 8 and at least similarly distinguish over the APA, respectively.

Amended independent claim 14 recites features similar to those of claim 1 noted above and thus similarly distinguishes over the 'APA. Claims 17-20 depend from claim 14 at least similarly distinguish over the APA, respectively.

The White Paper cannot make up for the shortcomings of the APA noted above in the traversal of the §102 rejection. Accordingly, the §103(a) rejection of claims 5, 6, 11, 12, 14 and 17-20 over the combination of the APA and The White Paper is improper and Applicants request that it be withdrawn.

**New Claims 21-23**

Again, claims 21-23 have been added by this reply. Claims 20-23 depend from claims 1, 8 & 14 and at least similarly distinguish over the applied art, respectively.

In the alternative, a distinction of claims 21-23 over the applied art is automatic evaluation of one or more alternate orders by which the proposed changes can be effectuated to identify whether a valid order exists that would not violate the set of constraints.

**CONCLUSION**

The issues raised in the Office Action are considered resolved. Accordingly, Applicants once again request a Notice of Allowability.

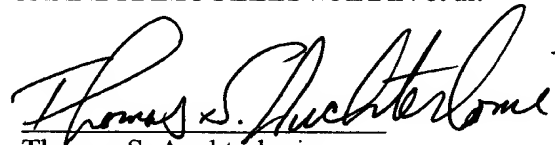
**Person to Contact**

In the event that any matters remain at issue in the application, the Examiners are invited to contact the undersigned for the purpose of a telephonic interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-2025 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,  
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